



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER FILING DATE FIRST NAMED INVENTOR ATTORNEY DOCKET NO.

07/715,258 06/14/91 WILLIAMS

J DS/91068
EXAMINER

LUCAS, S

29H2/0604

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ART UNIT PAPER NUMBER

2901
DATE MAILED:

06/04/93

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 5-24-93 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 15 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claim 15 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with Informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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1. The proposed additional or amended illustration has been entered, however said amendment introduces new matter (35 U.S.C. 132, 37 CFR 1.118). Due to the differences between the original and the new drawings, applicant's disclosure fails to comply with the description requirement of 35 U.S.C. 112, first paragraph. Accordingly, the claim is rejected in that the disclosure does not satisfy the description requirement of 35 U.S.C. 112, first paragraph. (In re Kaslow, 217 USPQ 1089 and In re Rasmussen, 211 USPQ 323).

The disclosure of the rectangular display screen in broken lines in the new drawing figures is held to be new matter. It is noted that the words "computer display" appear in the title. However these words, which are relatively vague as no actual structures, such as screen or panel, are identified, are not held to be sufficient support for the addition of a computer display screen, whether claimed or not, to the actual drawing disclosure. Moreover the addition of broken lines to the drawing disclosure is not necessary to secure correspondence between the drawing disclosure and the claims, since the claim is directed to an icon for a computer display, not a computer display, and the original drawing figures show an icon.

2. The rejection of the claim under 35 USC 171 as non-statutory subject matter is repeated and made final. Applicant's traverse has been carefully considered; however Board of Appeals in the decision of Ex parte Strijland, 26 USPQ 2d 1250 (BOPAI 1992) clearly stated that the display of the design as a picture on a screen is not sufficient to convert a picture into an article of manufacture. To overcome the rejection applicant would have to disclose the computerized system and to show as well that the

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design is not merely a displayed picture, but an integral and active part of that system.

3. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan J. Lucas whose telephone number is (703) 305-3265.


SUSAN J. LUCAS
EXAMINER
GROUP ART UNIT 291